# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 09/741,571 | 12/19/2000 | Kathryn L. Parker | MS #155647.1/40062.88-US- | 5903 |

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|---|---|

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|---|
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| 2154 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/741,571 | PARKER ET AL. |
| | Examiner | Art Unit |
| | Haresh Patel | 2154 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *12 November 2007*.

2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *6,8-18 and 26-35* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) *6,8 and 35* is/are allowed.

6) ☒ Claim(s) *9-18 and 26-34* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *10/31/07*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

1.      Claims 6, 8-18, 26-35 are subject to examination.  Claims 1-5, 7, 19-25 are cancelled.

Claims 6, 8 and 35 are allowed.

### *Response to Arguments*

2.      Applicant's arguments dated 11/12/2007 with respect to the amended claims 6 and 8 and

new claim 35, i.e., The claims of the present invention, particularly as now amended, thus

provide for an "environmental notification mode." See, e.g., claim 6. Further, the claim language

embodies the several layers of notification embodied by the present invention and which are

missing in Major. For example, in an embodiment of the present invention, the user may place

the small computer device into a meeting mode (Layer 1) which draws upon the associated

stored meeting profile (Layer 2) for that user which, in turn, stores the user's preferences for

notification types (Layer 4) for associated notification events (Layer 3) based on the user's

environment. The present invention's four-layer structure, in an embodiment as claimed, is

illustrated as follows in the exemplary schematic below: --) ]Set in Meeting Mod~ --) Retrieve

Stored Meeting Profile -) Notification Events for Meeting Profile o Calendar Reminder o Email

Message o Priority Email Message --)Notification Types for Events for Meeting Profile o

Audible o Visual Display o Vibration, etc., is persuasive and hence claims 6, 8 and 35 are

allowable. Regarding the remaining claims please refer to the responses of the office action dated

10/31/2007, 7/13/2007, etc of the prosecution history.

## *IDS*

3.    The IDS dated 10/31/2007 is acknowledged and attached is the initialed copy.

## *Claim Rejections - 35 USC § 102*

4.    The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

5.    Claims 9-18 and 26, 27, 30-34 are rejected under 35 U.S.C. 102(e) as being anticipated

by Major et al. 7,209,955, Research In Motion Limited (Hereinafter Major-Research-In-Motion).

6.    Referring to claim 9, Major-Research-In-Motion discloses a computer system for

notifying a user of notification events with a predetermined notification type based on the user's

environment (usage of communication device, software program and storage medium of the

device for supporting notifications as per user selections for different notification events, col., 8,

lines 22 – 46, col., 10, lines 23 – 43), the system comprising:

a memory unit (usage of RAM, FLASH memory, etc., col., 14, lines 25 – 35) storing a

(usage of the storage medium to store notification profiles, col., 8, lines 22 – 46, col., 10, lines 23

– 43) plurality of notification profiles (usage of different profiles i.e., calendar notification events profile, instant notification events profile, email message events profile, reminder profile, figure 6, col., 10, lines 23 – 43) for a user (for a particular user, col., 10, lines 3 – 9), such that each notification profile is assigned a predetermined environmental notification mode (usage of predetermined priority levels, regular versus very important and predetermined alert types, audible, visual, vibrate, figure 6, col., 12, lines 25 - 65) and such that within each notification profile are notification events (different email message notifications, different calendar events, different instant notifications, reminder alerts, figure 6, col., 12, lines 25 – 65) such that each of the notification events is assigned a notification type (different events assigned i.e., tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and usage of priority ranking, to notify user as per user specified selections, figure 6, col., 12, lines 25 – 65).

a first output unit (usage of one of the output units, for notifying audile tune 1 or tune 2, verbal 1 or verbal 2; for notifying visual alert; for notifying vibrate alert using vibrate 1 or vibrate 2, figure 6, col., 8, lines 9 – 28) notifying the user of a first notification event using a first notification type (notifying user using one of the different events using tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and priority ranking, figure 6, col., 12, lines 25 – 65);

a second output unit (usage of another output units, for notifying audile tune 1 or tune 2, verbal 1 or verbal 2; for notifying visual alert; for notifying vibrate alert using vibrate 1 or vibrate 2, figure 6, col., 8, lines 9 – 28) notifying the user of the first notification event using a second notification type (notifying user using one of the different events using tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2, and priority ranking, figure 6, col., 12, lines 25 – 65, col., 11, lines 48 - 67) such that the second notification type is different from the first

notification type (usage of different notification types, i.e., tune 1 or tune 2 or verbal 1 or verbal

2 or vibrate 1 or vibrate 2, and priority ranking, figure 6, col., 12, lines 25 – 65);

a processing unit (usage of processor of the communication device, col., 8, lines 22 – 38)

in response to a profile selected from the plurality of profiles (one of different profiles i.e.,

calendar notification events profile, instant notification events profile, email message events

profile, reminder profile, figure 6, col., 10, lines 23 – 43) in the memory unit (usage of RAM,

FLASH memory, etc., col., 14, lines 25 – 35) in response to the notification event (notification

event for the user), automatically determining (without manual intervention determining of

which tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2 to use for the event, figure

6, col., 12, lines 25 – 65) whether to notify the user using the first notification type or the second

notification type (whether to use tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2,

and priority ranking, to notify user as per user specified selections, figure 6, col., 12, lines 25 –

65); and

the processing unit (usage of processor of the communication device, col., 8, lines 22 –

38) utilizing the first or second output unit to notify the user (utilizing one of the output units for

notifying the user using audile alert by tune 1 or tune 2, verbal 1 or verbal 2; or visual alert; or

vibrate alert by vibrate 1 or vibrate 2, figure 6, col., 8, lines 9 – 28).

Note: Page 19, lines 16 – 21 of the specification of this appliaction under prosecution,

clearly states, "Although the invention has been described in language specific to structural

features and/or methodological steps, it is to be understood that the invention defined in the

appended claims is not necessarily limited to the specific features or steps described. Rather, the

specific features and steps are disclosed as preferred fonns of implementing the claimed

invention. Since many embodiments of the invention can be made without departing from the

spirit and scope of the invention, the invention resides in the claims hereinafter appended".


Note: Regarding the applicant's usage of "wherein" and/or "whereby" in the claimed

subject matter of the claims, the claim scope is not limited by claim language that suggests or

makes optional but does not require steps to be performed, or by claim language that does not

limit a claim to a particular structure. Please see Minton v. Nat 'l Ass 'n of Securities Dealers,

Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003. MPEP 2111.


7.      Referring to claims 10 and 33, Major-Research-In-Motion discloses the claimed

limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses wherein a

type of notification event, the notification event is a reception of email over a wireless network

(usage of wireless network and email message, col., 7, lines 60 – 67, col., 8, lines 50 - 56).


8.      Referring to claims 11 and 34, Major-Research-In-Motion discloses the claimed

limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses wherein the

notification event is a calendar event stored by a calendar-type application program (usage of

calendar application for supporting calendar notification events, col., 13, lines 4 – 35, col., 10,

lines 25 – 44).

9.     Referring to claims 12 and 28, Major-Research-In-Motion discloses the claimed

limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses wherein the

first notification type is an audible signal (usage of tune 1 or tune 2 or verbal 1 or verbal 2, figure

6, col., 12, lines 25 – 65) and the second notification type is a visual display (usage of visual

notification type, figure 6, col., 12, lines 25 – 65).


10.     Referring to claims 13 and 29, Major-Research-In-Motion discloses the claimed

limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses wherein the

first notification type is a vibration signal (usage of vibrate 1 or vibrate 2, figure 6, col., 12, lines

25 – 65) and the second notification type is an audible signal (usage of tune 1 or tune 2 or verbal

1 or verbal 2, figure 6, col., 12, lines 25 – 65).


11.     Referring to claims 14 and 30, Major-Research-In-Motion discloses the claimed

limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses wherein the

stored notification profiles include an assignment of a particular sound file to a particular event

(usage of file supporting tune 1 or tune 2 or verbal 1 or verbal 2, figure 6, col., 12, lines 25 – 65,

usage of audio files or clips, col., 8, lines 2 - 14).


12.     Referring to claims 15 and 31, Major-Research-In-Motion discloses the claimed

limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses wherein each

profile comprises two event notification types based on a user's environment (usage of

notification types based on user environment including noise level around the user, col., 14, lines

7 – 24).

13.    Referring to claims 16 and 32, Major-Research-In-Motion discloses the claimed

limitations rejected under claims 6 and 9. Major-Research-In-Motion also discloses wherein a

user capable of being notified of an event in a plurality of ways, depending on a selected profile

(usage of different events i.e., tune 1 or tune 2 or verbal 1 or verbal 2 or vibrate 1 or vibrate 2,

and usage of priority ranking, as per user selected profile i.e., for calendar profile versus email

message profile, col., 11, lines 48 - 67, figure 6, col., 12, lines 25 – 65).

14.    Referring to claim 17, Major-Research-In-Motion discloses the claimed limitations

rejected under claims 9 and 16. Major-Research-In-Motion also discloses wherein user has a

plurality of profiles (user having calendar profile versus email message profile, instant

notification profile, reminder profile, col., 11, lines 48 - 67, figure 6, col., 12, lines 25 – 65).

15.    Referring to claim 18, Major-Research-In-Motion discloses the claimed limitations

rejected under claims 9, 16 and 17. Major-Research-In-Motion also discloses wherein each of the

plurality of profiles (user having calendar profile versus email message profile, instant

notification profile, reminder profile, col., 11, lines 48 - 67, figure 6, col., 12, lines 25 – 65)

contains a plurality of notifications events (calendar events, email message events, instant

notification events, reminder events, col., 11, lines 48 - 67, figure 6, col., 12, lines 25 – 65) and

assigned notification types (different assigned i.e., tune 1 or tune 2 or verbal 1 or verbal 2 or

vibrate 1 or vibrate 2, and usage of priority ranking, to notify user as per user specified

selections, figure 6, col., 12, lines 25 – 65).

16.     Referring to claim 26, Major-Research-In-Motion discloses the claimed limitations

rejected under claim 6. Major-Research-In-Motion also discloses wherein the computer process

for notifying a user of a small computer device of notification events further comprises: selecting

a particular notification mode (usage of software program for selecting the notification mode,

col., 12, lines 6 – 48, for example, selection of calendar event that is audibly alerted and email

message event visually alerted, col., 11, lines 49 - 60) to modify a notification profile assigned to

that mode (updating of one of the calendar notification events profile, instant notification events

profile, email message events profile, reminder profile and priority levels, regular versus very

important and predetermined alert types, audible, visual, vibrate, etc., figure 6, col., 10, lines 23

– 43, col., 12, lines 25 - 65); modifying the notification profile (updating of the notification

profile, figure 6, col., 10, lines 23 – 43, col., 12, lines 25 - 65); and storing the modified profile

(usage of RAM, FLASH memory, etc., col., 14, lines 25 – 35 to store updated profile, col., 8,

lines 22 – 46, col., 10, lines 23 – 43).

17.     Referring to claim 27, Major-Research-In-Motion discloses the claimed limitations

rejected under claim 6. Major-Research-In-Motion also discloses wherein the computer process

for notifying a user of a small computer device of notification events further comprises:

assigning a plurality of volume levels (usage of adjusting volume level associated with

notification, adjusting of volume level of audible signal as per the user environment requirement,

col., 14, lines 7 – 34) of the small computer device (of the communication device such as hand-

held two-way wireless paging computer, palm-top computer, mobile telephone, col., 8, lines 22 –

46, col., 10, lines 23 – 43), with different notification types assigned to notification events (using

different events assigned with notification types, i.e., tune 1 or tune 2 or verbal 1 or verbal 2 or

vibrate 1 or vibrate 2, and usage of priority ranking, figure 6, col., 12, lines 25 – 65) within a

notification profile (of the updated notification profile, figure 6, col., 10, lines 23 – 43, col., 12,

lines 25 - 65); and selecting volume levels for different notification types (adjusting volume level

associated with notification depending upon different notification types, adjusting of volume

level of audible signal as per the user environment requirement, col., 14, lines 7 – 34) assigned to

notification events within a notification profile (of the updated notification profile having

notification events, figure 6, col., 10, lines 23 – 43, col., 12, lines 25 - 65).

### *Claim Rejections - 35 USC § 103*

18.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

19.     Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Major

et al. 7,209,955, Research In Motion Limited (Hereinafter Major-Research-In-Motion) in view of

"Official Notice".

Regarding claims 28 and 29, Major-Research-In-Motion does not specifically mention

about message comprising text and flashing light. "Official Notice" is taken that both the concept

and advantages of providing message comprising text and flashing light is well known and

expected in the art. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to include message comprising text and flashing light with the teachings of

Major-Research-In-Motion in order to facilitate usage of the text and/or flashing light for

notifying the user about an event because it would alert the user regarding the event. One of

ordinary skilled in the art at the time of the invention very well knows about the text and/or

flashing light are among well-known design choices that are used for alerting the user for events.


### *Allowable Subject Matter*

Claims 6, 8 and 35 allowed.


### *Conclusion*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The

examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to

8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the

organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Haresh Patel**

**PRIMARY EXAMINER**

**January 20, 2008**